

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KURT M. ANDERSON

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Appeal No. 1997-2036  
Application No. 08/335,991<sup>1</sup>

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HEARD: January 10, 2000

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Before THOMAS, RUGGIERO, and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, which are all of the claims pending in this application.

The appellant's invention relates to a multi-stage diffusion buffer for a disk drive which includes fluid

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<sup>1</sup> Application for patent filed November 8, 1994.

communication with the surrounding environment. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A diffusion structure for allowing fluid flow between an interior of a disk drive and a surrounding external environment, comprising:

an entry channel having a first end connected to the external environment, and a second end at an opposite end of said entry channel;

a plurality of chambers, a first chamber of said plurality of chambers connected to said second end of said entry channel, and a second chamber connected to the interior of the disk drive;

a plurality of channels interconnected between said plurality of chambers, said plurality of channels inhibiting flow between said plurality of chambers at least at certain fluid flow rates;

a housing for the disk drive in which said entry channel, said plurality of chambers and plurality of channels are formed; and

a cover affixed to said housing over said plurality of chambers and plurality of channels so as to define a diffusion path through said plurality of chambers and plurality of channels.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:<sup>2</sup>

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<sup>2</sup> Gitzendanner, PN 4,620,248, Morehouse et al., PN 5,025,336, Stefansky et al., PN 5,029,026, and Inoue, JP 62-279588 are all cited in the prior art section of the Examiner's Answer but were not applied in any rejections.

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Blanks	4,751,594	Jun. 14, 1988
Dion	5,307,222	Apr. 26,
1994		
Brown et al. (Brown)	5,447,695	Sep. 05, 1995

Claim 4 stands rejected under 35 U.S.C. § 102 as being anticipated by Brown.

Claims 1 through 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Blanks, and further in view of Dion with respect to claim 3.

Reference is made to the Final Rejection (Paper No. 9), mailed March 25, 1996) and the Examiner's Answer (Paper No. 16, mailed November 25, 1996) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 15, filed August 26, 1996) for appellant's arguments thereagainst.

#### OPINION

As a preliminary matter we note that appellant indicates on page 7 of the Brief that the claims are not to stand or fall together. Appellant states that claims 1 through 3 should be considered as one group and claim 4 as a second

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Therefore, we have not considered them.

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group and provides arguments as to the separate patentability of each group in accordance with 37 CFR § 1.192(c)(7).

Therefore, we will treat the claims as falling into the two groups proposed by appellant, with claims 1 and 4, respectively, as representative.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we

will reverse both the anticipation rejection of claim 4 and also the obviousness rejection of claims 1 through 3.

"It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim," In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). See also, Lindemann Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). In the present case, claim 4 requires, in pertinent part, a plurality of buffer chambers with a plurality of connecting channels

therebetween. In applying Brown against claim 4, the examiner asserts (Final Rejection, page 3) that elements 62, 66, and 81 meet the limitation of buffer chambers and elements 82 and 83 refer to channels. Appellant admits (pages 12-13) that element 66 could be considered a chamber and that elements 82 and 83 are channels. However, appellant contends that elements 62 and 81 are not chambers and, therefore, that claim 4 is not anticipated.

Brown identifies 62 as the housing, rather than a chamber. Although a housing generally has dimensions similar to those of a chamber, the chambers in claim 4 have certain restrictions that are not met by element 62. For example, housing 62 is not connected to other chambers by connecting channels, as recited in

claim 4. Further, housing 62 is not part of the second diffusion path and, therefore, does not carry fluid, as recited in and implied by claim 4. Accordingly, element 62 cannot be one of the plurality of chambers recited in claim 4.

As to channel 81 being considered a chamber, the examiner argues (Answer, page 4) that the term "channel" meets

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Webster's definition of "chamber," "an enclosed space or compartment." Further, the examiner asserts (Answer, page 4) that "neither the claims nor the specification recite a structure of channels or chambers which clearly differentiates the two elements," explaining that appellant's preferred dimensions do not distinguish between the two terms because appellant discloses that the dimensions may vary.

Appellant's use of two separate terms in the claims, "channel" and "chamber," at the very least implies different types of elements. Also, the words "channel" and "chamber" differ in meaning. Channels must have an opening at the top and bottom, as they carry some form of fluid, whereas a chamber (as quoted by the examiner) is "an enclosed space or compartment" (emphasis added). (Chambers can have doors or openings, but channels cannot be completely enclosed.) Further, relative to chambers, channels have a higher length to width ratio.

In addition, appellant indicates in the specification and drawings an intent for the terms to refer to different types of elements. Note, as pointed out by appellant (Brief, pages

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15-16), that the court has held in E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 7 USPQ2d 1129 (Fed. Cir. 1988), that

[i]t is entirely proper to use the specification to interpret what the Patentee meant by a word or phrase in the claim. [citation omitted]. But this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By "extraneous," we mean a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim. (brief, page 16, emphasis in original).

Appellant shows in the drawings chambers with a low aspect ratio and channels which are long and narrow. In the specification (page 14) appellant discloses preferred dimensions of the channels and chambers. Although appellant states that the specific size may vary, the preferred dimensions indicate the relative aspect ratios, which are on the order of 100:1 for channels and 1:1 for chambers. Accordingly, appellant has clearly distinguished between the two terms, and the examiner cannot arbitrarily treat them as being interchangeable.

Returning to Brown's element 81, Brown specifically refers to it as a channel. Brown shows channel 81 in the

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drawings as a long and narrow pathway, similar to elements 82 and 83, which are

also labeled as channels and which the examiner has applied against the claimed channels. Further, Brown's element 81 appears in the drawings similar to appellant's channels, which have been plainly distinguished from chambers above.

Therefore, Brown's element 81 clearly cannot be a chamber as recited in claim 4. Accordingly, Brown does not include plural chambers connected by channels, but rather at best includes one chamber (element 66) with three connected channels. Since Brown does not disclose every element of the claim, Brown does not anticipate claim 4. Consequently, we must reverse the rejection under 35 U.S.C. § 102.

As to the obviousness rejection of claims 1 through 3, the examiner submits (Final Rejection, page 4) that it would have been obvious to replace Brown's system of channels and chambers inside the disk drive with the same chambers and channels, "but placed on the exterior of the disk drive and laid completely on a plane parallel to the disk drive wall to which the cover was connected as the one disclosed by Blanks."



The examiner's rationale for modifying Brown's system is "to reduce the number of components inside the disk drive and to allow reduction of its size, as well as to allow possible access to the channels without disturbing the interior of the disk drive." The examiner

proposes (Final Rejection, page 5) further modifying Brown by forming the channels on the disk drive housing rather than on the cap, "as part of a routine structure optimization process aimed to minimize the number of steps involved in the fabrication of the disk drive."

As thoroughly discussed above, Brown does not include plural chambers as required by the method of claim 4. Claims 1 through 3 define a structure with the same limitation of plural chambers, with plural channels interconnected between the chambers. Accordingly, Brown lacks the plural chambers required for claims 1 through 3. The examiner's statements notwithstanding, Blanks discloses a channel 12 and no

chambers. Accordingly, Blanks does not cure the deficiencies of Brown.<sup>3</sup>

Furthermore, in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is required to provide a reason why one having ordinary skill in the pertinent art would have been led to

modify the prior art to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note

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<sup>3</sup> We note that Dion was added in the rejection of claim 3. However, since claims 1 through 3 have been grouped together, and appellant has not provided any arguments as to the applicability of Dion, we will not discuss Dion further in this decision.

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In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, "[t]hat knowledge can not come from the applicant's invention itself." Oetiker, 977 F.2d at 1447, 24 USPQ2d at 1446.

The examiner has provided no teaching, suggestion or implication from the prior art for the proposed modifications of Brown. Although Blanks includes a channel on a vent cap, there is no suggestion in Blanks to move a system of channels from the inside of the disk drive cover to a cap exterior to the disk drive, nor to move it then to the exterior of the disk drive housing. Further, there is no suggestion in either reference to reorient the channels of Brown to be all in a plane parallel to the disk drive wall. The examiner has merely used impermissible

hindsight to arrive at the claimed invention. Accordingly, the examiner has failed to establish a prima facie case of obviousness. Therefore, we must reverse the obviousness rejection of claims 1 through 3.

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CONCLUSION

The decision of the examiner rejecting claim 4 under 35 U.S.C. § 102 is reversed. The decision of the examiner rejecting claims 1 through 3 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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